

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of
Katsunobu HAYASHI

Confirmation No.: 7831

Appl. No.: 09/683,829

Tech. Center: 3694

Filed : February 20, 2002

Examiner: Mary Da Zhi Wang CHEUNG

For : COMPENSATION CONTRACT SUPPORTING SYSTEM, METHOD FOR
SUPPORTING COMPENSATION CONTRACT, AND PROGRAM THEREOF

**PETITION UNDER 37 C.F.R. 1.181 FOR WITHDRAWAL OF HOLDING OF
ABANDONMENT**

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Petition under 37 C.F.R. 1.181 requesting withdrawal of the holding of abandonment of October 8, 2008 in the above-identified application.

TIMELY FILING OF PETITION

In accordance with 37 C.F.R. 1.181(f), this Petition is prima facie timely filed, as it is filed within two months of the October 8, 2008 mailing of the Notice of Abandonment. Applicant has expeditiously taken action after reviewing the Notice of Abandonment of October 8, 2008 and a time line of the events is described below.

BACKGROUND

Applicant's representative's Firm has volunteered to receive electronic

communications from the USPTO regarding communications from the Office, in lieu of paper communications. This is a fairly new program that is promoted by the USPTO in order to expedite prosecution as it can be beneficial both to the USPTO as well as to applicants.

The processing of these communications is briefly described herein. First, the USPTO sends an e-mail to a designated e-mail address that belongs to the Firm of Applicant's representative (hereinafter as "Applicant"), informing the recipient that the USPTO has a communication with respect to a particular patent application. Then, the Applicant would access the Patent Application Information Retrieval System (Private PAIR) to view and retrieve the communication. Typically, the Applicant would then print out a copy of the communication, docket the response due date, a date for reporting the action to the client, and other applicable deadlines. Applicant would then match the communication with Applicant's file and move forward with prosecution.

In volunteering participation in this new method of communication, the Applicant was assured by the USPTO that it has additional processes to safeguard the traditional form of communication, i.e., proper paper mailing of documents, by implementing other steps in case of non-receipt of the e-mail or non-retrieval of the communications electronically. For example, it is the Applicant's understanding that somehow, the USPTO would know if a communication is not reviewed by Applicant for any reason, such as non-receipt or mishandling of an e-mail. In the event that this happens, the Office would send a postcard to Applicant to inform Applicant that the communication has not been reviewed.

As such, Applicant has on a few occasions, received such postcards from the USPTO. However, this was not the case for the present application.

PROSECUTION TIMELINE

The following is a brief outline of the prosecution history just prior to the Notice of Abandonment of October 8, 2008 and events pertinent to the instant application.

On September 10, 2007, a Non-Final Rejection was mailed.

On December 6, 2007, Applicant filed a Response to the Non-Final Rejection.

On October 8, 2008, Applicant received an e-mail notification of an Office Action from the USPTO. Applicant then immediately accessed PAIR, printed the document and matched it with the file. As the Office Action was a Notice of Abandonment, Applicant reviewed the file and was surprised to see that the file did not have an Office Action after Applicant's filed Response of December 6, 2007. Furthermore, when an Office Action is received by Applicant's representative, a copy of the Office Action is sent and reported to the client. There were no records of such in the file for the present application. Applicant then reviewed PAIR and saw that an Office Action was "mailed" on March 18, 2008. Only upon seeing this did Applicant print out a copy of that Office Action. At that point, an employee of the Firm of the undersigned called the USPTO to inquire about the situation. A USPTO official stated that records indicated that for this Office Action, there was an e-mail notification on March 18, 2008 and an electronic review of the document on March 19, 2008. While Petitioner is not in a position to prove that the PTO records regarding review of the e-

mail notification are incorrect, the Firm employees handling these types of communications were consulted and they do not recall specifics of this case. A review of the Firm's electronic records and paper file do not reveal the presence of the Office Action of March 18, 2008, or any PTO post card reminder that the Private PAIR records were not reviewed for that Office Action. Furthermore, the Firm's docket system includes no entries for responding to the Office Action of March 18, 2008, or for reporting that action to the client.

Thus, Applicant was not alerted to review the Office Action dated March 18, 2008. Applicant further notes that it is customary for the Examiner to call the Applicant prior to sending out a Notice of Abandonment, in order to confirm that an application is to be abandoned. In fact, Applicant has received calls on many occasions from other Examiners to confirm abandonment in situations where an application was to be abandoned. In this case, Applicant never received a call from the Examiner inquiring about a response that may have been filed.

CONCLUSION AND REQUEST

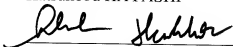
Applicant cannot explain the discrepancies between USPTO's records and those of Applicant's with respect to the review of the Office Action dated March 18, 2008. It appears that there are at least two differences in terms of the USPTO's action with respect to the situation at hand as compared to those that Applicant experienced in the past with PTO actions. For example, Applicant did not receive a postcard from the USPTO, nor did the Examiner call to check the intent to abandon, which are two safe guards that the USPTO has

instituted in order to induce practitioners to volunteer and participate in this new form of communication. Applicant understands that as new systems and methods of doing business are instituted by the USPTO, there continue to be glitches in the system and improvement is an ongoing process. The undersigned asserts that this is the first instance at the Firm where the electronic communication has failed in this manner. It is hereby requested that the holding of abandonment be withdrawn in this case and that the Deciding Official re-start the period for filing a response from the date that Applicant first became aware of the Office Action, which is October 8, 2008.

A fee is not believed to be required by the filing of this Petition. However, if any fees are required for consideration of this Petition, or to reinstate the pendency of the application, the Commissioner is hereby authorized to charge such fees to Deposit Account No. 50-2929 making reference to docket number P13205.

Should the Examiner have any questions or comments regarding this matter, the undersigned may be contacted at the below-listed telephone number.

Respectfully submitted,
Katsunobu HAYASHI

A handwritten signature in dark ink, appearing to read 'Abraham Herskovitz', is written over a horizontal line.

Abraham Herskovitz
Reg. No. 45,294

October 20, 2008
HERSHKOVITZ & ASSOCIATES, LLC
2845 DUKE STREET
ALEXANDRIA, VA 22314

703-370-4800 (telephone)
703-370-4809 (facsimile)

patent@hershkovitz.net